REMARKS

This is a Response to Office Action dated April 24, 1997. Claims 2-38 have been amended. Originally presented Claim 39 has been correctly renumbered following the Examiner's instructions. Applicants respectfully request reconsideration in view of the above amendments and the arguments presented below.

Rejection of the Claims

Rejections Under 35 U.S.C. § 112, Second Paragraph

On pages 2 of the Office Action, the Examiner rejects Claim 25 under 35 U.S.C. § 112 as follows:

> Claim 25 is rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention. The references to the "first participant" and "second participant" are reversed in Claim 25.

In response, Applicants have amended Claim 5 so that proper ordering between the "calling participants" and "first participant" is established.

Rejections Under 35 U.S.C. § 102(a)

On pages 2-5 of the Office Action, the Examiner rejects Claims 2, 5, 7-10, 22, 23, 26, 29, 31 and 33 as being anticipated by *"Software Architecture for Integration of Video Services in the Etherphone System"* by Rangan et al. More specifically, the Examiner states:

> As per claim 23, Rangan teaches a method for teleconference among participants essentially as claimed, comprising the step of:
> a)   detecting an incoming teleconference call [p. 1398 fig. 4 - Notif], at the workstation of a first participant [p. 1399 4th paragraph - "...pictures are display... when he is notified of an incoming call"];
> b)   notifying the first participant [fig. 4 - ring] of the identity of each participant forming the teleconference call [p. 1397 col. 1 lines 3-5]; and
> c)   providing the first participant with option of accepting the incoming teleconference call [p. 1397 col. 1 lines 1-2].
> As per claim 2, it is rejected under similar rationale as for claim 23 above. Rangan discloses that a participant can be in multiple conferences [p. 1400]. It is apparent that when a second call come in the first participant would be notified of the call the participant in the calls.
> As per claims 5 and 26, Rangan disclosed indicating priority teleconference call [apparent from p. 1399 col. 1 first paragraph].
> As per claims 7 and 28, Rangan teaches placing active call on hold and accepting incoming call [p. 1401 col. 1 first paragraph - 'relegated to background', and last sentence of third paragraph].

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As per claims 8 and 29, Rangan teaches indicating status of the call to the first participant [p. 1398 col. 1 third paragraph "Conference Model"].

As per claim 9, Rangan teaches displaying the originator of the call [p. 1397 1st paragraph].

As per claims 10 and 31, Rangan teaches adding participant to the conference [p. 1401 col. 1 2nd paragraph "The caller...can add or delete recipients...dynamically."]

As per claims 22, 33, Rangan teaches placing a participant on hold [p. 1401 col. 2 2nd paragraph "Any participant can change his desired access modes or reselect his foreground conference", 3rd paragraph "Users can...switching between conferences by changing the mode of access...so as to put it on hold..."].

Rangan teaches disconnect a participant while maintaining the conference [p. 1401 col. 1 2nd paragraph "The caller...can add or delete recipients...dynamically."].

Applicants respectfully disagree that the Rangan et al. reference anticipates these claims. In particular, independent apparatus Claim 2 contains an "incoming call acceptance mechanism" capable of notifying a participant (a person using the system) in an *existing* teleconference of an incoming call. This participant (the user) then has the option of accepting the incoming call. This is clear from the words "*if* the first participant is engaged in an active teleconference...". (emphasis supplied). Similarly, independent method Claim 23 contains the steps of "detecting," "notifying" and "providing the first participant with the option of accepting [an] incoming teleconference call...*during* an active teleconference...". (emphasis supplied). Thus the independent claims in this application are directed at the notion of incoming call detection by a participant in an *active* teleconference.

By contrast, Rangan et al. only allows idle (inactive, not busy) users to join a conference. This is clear from the text "Each of the recipients who is idle, i.e., currently not in any other conference, receives an invitation to join a conference."[1] This is also reinforced by Rangan Figure 4 discussed below. Thus, in Rangan, only idle users can accept an invitation to join a call. In other words, unlike Rangan et al., the claimed invention allows a participant, in an "existing" teleconference, to respond to an incoming call, not initiated by any participant in the "existing" conference, by accepting that incoming call.

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[1] Rangan, Page 1396, 2nd column, 4 to 6 lines the bottom.

Furthermore, the Rangan description on page 1401, Col. 1 does not add anything beyond this. This section of the Rangan reference describes how an inanimate "agent" automatically selects which conference is displayed to a user. Thus, the user is not given any option of which call to accept at the time the call comes in.

Therefore, as Rangan does not teach all the claim limitations it cannot be support a rejection of independent Claims 2 and 23 under Section 102(a).

Now, the Examiner may wish to argue that Rangan renders the independent claims obvious. To support such an argument the Examiner must show that "the [Rangan] reference[s] expressly or impliedly suggest the claimed invention" or "must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the reference[s]."[2] It is respectfully submitted that this required showing or reasoning cannot be based on the Rangan reference.

First, as indicated above, Rangan does not only allow an "active" user (the person) to receive and respond to an invitation to join a teleconference. Thus Rangan does not expressly suggest the claimed invention.

Second, Rangan does not imply the claimed invention. In fact, it teaches away from it. This is clear from the "Model of state transitions" shown in Figure 4, page 1398 and its related discussion under the heading "Conference Model" in column 1 of page 1398. In this Figure 4 the only way for a Recipient to transition to the *notified* state (Notif on the Figure) is from the Idle state. This is clear from the directions of the arrowheads showed in this figure and, in particular, the direction of the arrow from the Idle to the Notif state. The diagram in Figure 5, in particular the right hand side of the diagram, reconfirms this configuration.

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[2] M.P.E.P. § 2143 (Rev.2, July 1996) (Citing *Ex Parte Clapp*, 227 U.S.P.Q. 972, 973 (Bd. Pat. App. & Inter. 1985)).

In contrast, the state diagram for the claimed invention would be much more sophisticated. At a minimum it would also include an arrow pointing *from* an Active state *to* the Notif state to indicate that an active participant can be notified. This configuration is not even contemplated by the Rangan call model. How then can the claimed invention be obvious over the Rangan reference?

Consequently, Applicants believe Claims 2 and 23 are in a condition for allowance. Furthermore, as all the other claims in this application depend on either Claim 2 or 23, all the dependent claims should also be allowable as depending on allowable base claims.

CONCLUSION

In conclusion, Applicants respectfully believe that independent Claims 2 and 23 are in a condition for allowance. Dependent Claims 3-22 and 24-38, which depend on Claim 2 and Claim 23 respectively, are also believed to be allowable as they depend on allowable base claims. Allowance at an early date would be appreciated. Should the Examiner have any questions or comments, he is encouraged to call the undersigned to discuss the same so that any outstanding issues can be expeditiously resolved.

Respectfully submitted,

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